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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/993,780

11/16/2001

John J. Daniels

14531.71.4.3

1576

47973

7590

05/02/2008

WORKMAN NYDEGGER/MICROSOFT  
1000 EAGLE GATE TOWER  
60 EAST SOUTH TEMPLE  
SALT LAKE CITY, UT 84111

EXAMINER

LEE, Y YOUNG

ART UNIT

PAPER NUMBER

2621

MAIL DATE

DELIVERY MODE

05/02/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/993,780	<b>Applicant(s)</b> DANIELS, JOHN J.	
	<b>Examiner</b> Y. Lee	<b>Art Unit</b> 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 3-7, 15, 37, 39, 40, 44-47, 64-76 and 78-80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-7, 15, 37, 39, 40, 44-47, 64-76 and 78-80 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 May 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings were received on 5/5/03. These drawings are acceptable.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3-7, 15, 37, 39, 40, 44-47, 64-76, and 78-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al (6,388,714) in view of Klosterman (5,550,576) for the same reasons as set forth in Section 4 of the last office action, dated 12/5/07.

With respect to the newly added claims 79 and 80, Figure 4 of Klosterman already illustrates the concept of such well known VCR control information.

### ***Response to Arguments***

4. Applicant's arguments filed 4/7/08 have been fully considered but they are not persuasive.
5. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding applicant's argument on pages 10-11 and 14 of the Remarks that neither Schein et al nor Klosterman discloses a server for storing and transmitting information over a

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network to a recording apparatus, it was clearly stated in the previous office action that Schein et al discloses all these means in Figure 14. It is true that Klosterman does not disclose any network details as that claimed by the Applicant. However, examiner does not rely on Klosterman to teach such capabilities because they are already disclosed in Schein et al. Klosterman merely provides the motivation that it would have been obvious to one of ordinary skill in the art at the time the invention was made, having both references of Schein et al and Klosterman before him/her, to modify the interactive system of Schein et al to be upgraded as a network controllable apparatus by simply utilizing VCR control information to control the VCR to include the same digital recording means and competitive processing equipment as specified in claims 3-7, 15, 37, 39, 40, 44-47, 64-76, and 78-80. With an upgraded interactive system, one of ordinary skill in the art would have had no difficulty in recognizing that the PC TV of Schein et al would be able to request a program and apply subsequent control processing such as recording, storing, and retrieving the transmitted images from the server through the network, as illustrated in Figures 10-11, since interactive processing are necessary and well known techniques for many digital recording systems.

6. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., recording instructions other than source ID, channel, and time information) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In particular, the phrase “recording instruction(s)” does not even appear in applicant's disclosure. The claimed invention does not appear to be described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Applicant asserts on page 13 of the Remarks that the prior art fails to teach “end of VCR” information. However, Figure 4 of Klosterman illustrates the concept of such well known information wherein the VCR turns off according to the end time information.

Applicant also asserts on page 13 of the Remarks that the prior art fails to disclose a digital signal. However, column 4, lines 54-64 of Schein et al explicitly state that the interactive television system is applicable to both the analog and digital formats.

Applicant further asserts on page 13 of the Remarks that the prior art fails to disclose the recording instructions are received in response to a selected program. However, one of ordinary skill in the art would have had no difficulty in recognizing that in order for a program to be selected for recording in Schein et al, the basic computer navigation technique of either clicking of a mouse button or hitting the "enter" key on a keyboard is required before the computer considers the program is selected.

Applicant finally asserts on pages 13-14 of the Remarks that the prior art fails to disclose a password. However, Figure 5 of Schein et al explicitly illustrates the concept of an account set up requirement before a user is able to access the interactive television system.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Y. Lee whose telephone number is (571) 272-7334. The examiner can normally be reached on (571) 272-7334.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Young Lee/  
Primary Examiner  
Art Unit 2621

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